

REMARKS

Claims 1-13 are currently pending in the present application. Applicant has cancelled claims 1 - 13 in lieu of claims 14 - 26 to further particularly point out and distinctly claim the subject matter which Applicant regards as the inventive subject matter. The amendments to the claims presented herein do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, the Examiner is respectfully requested to enter these amendments.

1. Rejection of Claims 1-13 Under 35 U.S.C. §102(b)/103(a)

The Office Action states,

Claims 1-13 remain rejected under 35 U.S.C.102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pellegatti et al., EP 0 640 649 B1 (hereinafter "Pellegatti"). Pellegatti discloses a polyolefin composition comprising (a) 30-60% propylene homopolymer, (b) 14-30% copolymers of propylene with ethylene, (c) 10-25% copolymer of ethylene/C₄-C₁₀ olefins and (d) 5-45% filler. See Pellegatti, page 2, lines 33-45. Although Pellegatti does not disclose all the characteristics and properties of the polymer components disclosed in the present claims, based on the overall monomer composition and the amount of each respective polyolefin component, the Examiner has a reasonable basis to believe that the properties claimed in the present invention is inherent in the compositions disclosed by Pellegatti. Because the PTO has no means to conduct analytical experiments, the burden of proof is shifted to the Applicants to prove that the properties are not inherent. See In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Best, 195 USPQ 430 (CCPA 1977); In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessary make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). However,

the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See In re Rijckaert, 9 F.3d. 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessary due to optimization of conditions, not what was necessarily present in the prior art). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing describe in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Even if the disclosure of Pellegatti does not satisfy the requirements of 35 USC 102(b), it still would have been obvious to one of ordinary skill in the art to arrive at the claimed compositions, because it appears that the claimed compositions are within the generic disclosure of Pellegatti and a person of ordinary skill in the art would have expected all embodiment of Pellegatti to have similar properties. Particularly, the use of an additional polyolefin component (instant claim 6) in the blend and 60-80% component (2) (instant claim 12) is obvious to one of ordinary skill in the art.

Pellegatti teaches the use of an assortment of polyolefins as a part of the overall composition. For instance, Pellegatti teaches propylene homopolymer or copolymer may be used as component (a). To one of ordinary skill the use of both is also a possibility considering that ethylene/propylene copolymers can be used as components (b) or (c). Also 55% of component (2) as taught by Pellegatti is sufficiently close to 60% as described in the claimed invention.

Applicant has not demonstrated that the differences, if any, between the claimed composition and the compositions disclosed by Pellegatti give rise to unexpected results.

The evidence presented to rebut the prima facie case of obviousness must be commensurate in scope with the claims to which it pertains. See *In re Dill and Scales*, 202 USPQ805 (CCPA 1979).

RESPONSE

Claims 1 - 13 have been cancelled rendering the above rejections moot.

Notwithstanding, for a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Emphasis added) The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added) The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Additionally, the U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness was determined under § 103 by (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

Applicant respectfully submits that Pellegatti, et al. fails to teach, suggest, or disclose, "A masterbatch composition comprising (percentage by weight):

- 1) 10-50% of a crystalline propylene homopolymer;
- 2) 50-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and 10-40% of at least one C₄-C₁₀ α -olefin of formula H₂C=CHR, where R is a C₂-C₈ linear or branched alkyl radical; and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a);

wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3, and the masterbatch composition comprises a flexural modulus equal to or lower than 700 MPa," as currently recited by claim 14.

In particular, Applicant respectfully submits that Pellegatti, et al. fails to teach, suggest, or disclose a masterbatch composition comprising a flexural modulus equal to or lower than 700 MPa, as currently claimed. In fact, the compositions disclosed in Pellegatti, et al. have flexural modulus values from 1300 to 1600 [MPa], preferably from 1350 to 1600 [MPa], and more preferably from 1400 to 1600 [MPa]. See page 3, paragraph 0014.

Applicant is aware the units disclosed in Pellegatti, et al. are in J/m and not MPa. However, Applicant believes this is an unintentional typographical error in the specification of Pellegatti, et al. given, (i) the unit of J/m is commonly used for Izod impact values, which are disclosed directly before the flexural modulus values, and (ii) in a preferred embodiment on page 8, paragraph 0057, the flexural modulus is disclosed as being 1400 MPa. Accordingly, Applicant believes the actual flexural modulus ranges disclosed in Pellegatti, et al. are in MPa and not J/m, and are thus clearly outside Applicant's currently claimed flexural modulus range.

Additionally, the Office Action states, "Although Pellegatti does not disclose all the characteristics and properties of the polymer components disclosed in the present claims, based on the overall monomer composition and the amount of each respective polyolefin component, the Examiner has a reasonable basis to believe that the properties claimed in the present invention is inherent in the compositions disclosed by Pellegatti."

Applicant respectfully traverses the Examiner's assertion that Pellegatti, et al. inherently contains all of the non-disclosed currently pending claim limitations. In particular, since the flexural modulus ranges disclosed by Pellegatti, et al. are different than those currently claimed, Applicant submits the Examiner has not provided a sufficient basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of Pellegatti, et al. as required by *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Moreover, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). (Emphasis added)

Furthermore, for the same reasons discussed *supra*, Applicant believes Pellegatti, et al. fails to teach, suggest, or disclose, "A thermoplastic polyolefin composition containing a masterbatch

composition comprising (percentage by weight):

- 1) 10-50% of a crystalline propylene homopolymer;
- 2) 50-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and 10-40% of at least one C_4-C_{10} α -olefin of formula $H_2C=CHR$, where R is a C_2-C_8 linear or branched alkyl radical; and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a);

wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3, and the masterbatch composition comprises a flexural modulus equal to or lower than 700 MPa," as currently recited by claim 17.

Moreover, for the same reasons discussed *supra*, Applicant believes Pellegatti, et al. fails to teach, suggest, or disclose "An automotive part comprising a masterbatch composition comprising (percentage by weight):

- 1) 10-50% of a crystalline propylene homopolymer;
- 2) 50-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and 10-40% of at least one C_4-C_{10} α -olefin of formula $H_2C=CHR$, where R is a C_2-C_8 linear or branched alkyl radical; and

b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a);

wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3, and the masterbatch composition comprises a flexural modulus equal to or lower than 700 MPa," as currently recited by claim 22.

Even more so, for the same reasons discussed *supra*, Applicant believes Pellegatti, et al. fails to teach, suggest, or disclose "A process for preparing a masterbatch composition comprising (percentage by weight):

- 1) 10-50% of a crystalline propylene homopolymer;
- 2) 50-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and 10-40% of at least one C₄-C₁₀ α -olefin of formula H₂C=CHR, where R is a C₂-C₈ linear or branched alkyl radical; and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a);

wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3 by a sequential polymerization, comprising at least three sequential steps, wherein components 1) and 2) are prepared in separate subsequent steps, operating in each step, except the first step, in the presence of the polymer formed and the catalyst used in the preceding step, and the masterbatch composition comprises a flexural modulus equal to or lower than 700 MPa," as currently recited by claim 23.

In light of the above, claims 14 - 26 are therefore believed to be patentable over the Pellegatti, et al. patent. Accordingly, reconsideration and withdrawal of the rejections is requested.

CONCLUSION

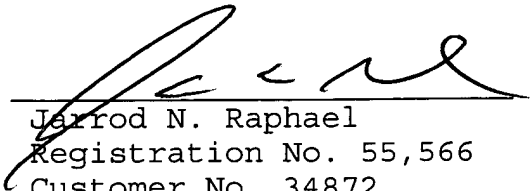
Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw all rejections and allow all pending claims 14 - 26. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner if he has any questions or comments.

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Respectfully submitted,

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